

O/0066/26

TRADE MARKS ACT 1994
CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS:
UK00004054442 AND UK00004054452

BY AMERICAN EXPRESS MARKETING & DEVELOPMENT CORP.
TO REGISTER THE TRADE MARKS:

AMERICAN EXPRESS VENUE COLLECTION

AND

AMEX VENUE COLLECTION

IN CLASSES 35, 41 AND 45

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS: 450545 & 450547
BY COMPASS GROUP, UK AND IRELAND LIMITED

BACKGROUND AND PLEADINGS

1. These consolidated proceedings involve oppositions against two trade marks that American Express Marketing & Development Corp. (“the applicant”) seeks to register in the UK. The details for those trade marks are set out below:

i) AMERICAN EXPRESS VENUE COLLECTION

UK application no. 4054442

Filing date: 21 May 2024

Publication date: 2 August 2024

Priority date: 26 April 2024 (USA)

(“the First Application”)

ii) AMEX VENUE COLLECTION

UK application no. 4054452

Filing date: 21 May 2024

Publication date: 2 August 2024

Priority date: 26 April 2024 (USA)

(“the Second Application”)

2. The above applications are in respect of identical services in classes 35, 41 and 45.¹

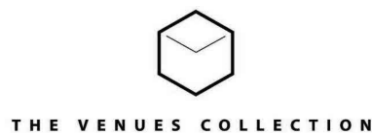
The related oppositions

3. The applicant’s marks are subject to two oppositions brought by Compass Group, UK and Ireland Limited (“the opponent”). The oppositions were brought on 4 November 2024 and are directed at all the applied-for services.

¹ See Annex 2 to this decision.

4. The oppositions were initially brought under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”),² however, in an email dated 13 March 2025, the opponent withdrew the section 5(4)(a) ground leaving section 5(2)(b) only. The opponent relies upon the following two earlier trade mark registrations for the purpose of its oppositions:

i)



(series of three)

UKTM 3447344

Filing date: 27 November 2019;

Registration date: 21 February 2020;

Registered in classes 39, 41, 43 and 45;

For the purpose of these proceedings the opponent relies upon all its services.³

(“the First Earlier Registration”)

² The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU. See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

³ See Annex 2 to this decision.

ii)



UKTM 3745101

Filing date: 19 January 2022;

Registration date: 22 April 2022;

Registered in classes 39, 41, 43 and 45;

For the purpose of these proceedings the opponent relies upon all its services.⁴

("the Second Earlier Mark")

5. The opponent submits that the respective marks are highly similar due to their near identical shared elements and that the services are identical or closely similar, resulting in a likelihood of confusion on the part of the relevant public, which includes a likelihood of association.

6. In its counterstatements whilst the applicant concedes that some of the respective services in classes 41 and 45 are identical, it denies any likelihood of confusion or association in the minds of the relevant public, due to clear differences between the respective marks.

7. On 11 January 2025, the Tribunal wrote to the parties informing them that the two opposition proceedings had been consolidated, pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.

8. The opponent's marks qualify as earlier marks under section 6(1) of the Act. As they had not completed their registration procedure more than five years before the application date for the contested marks, they are not subject to the use provisions contained in section 6A of the Act. Consequently, the opponent may rely upon all of the services for which the earlier marks are registered without having to establish genuine use.

⁴ See Annex 2 to this decision.

9. No hearing was requested, though both parties chose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers before me.

10. The opponent is represented by Barker Brettell LLP; the applicant is represented by Freeths LLP.

MY APPROACH

11. The First Earlier Registration consists of a series of three marks with the only difference being the use of colour. As the third mark in the series is registered in black and white it is covered for use in any colour, including that used in the first and second marks. Therefore, I will focus my assessment on the third mark in the series only. Going forward, I will simply refer to this as “the First Earlier Mark”.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) and 5A of the Act states that:

“5(2) A trade mark shall not be registered if because-

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

[...]

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

13. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG, Case C-251/95*, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97*, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97*, *Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98*, *Matratzen Concord GmbH v OHIM, Case C-3/03*, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04*, *Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P* and *Bimbo SA v OHIM, Case C-591/12P*:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

14. The parties' services are set out in Annexes 1 and 2 of this decision.

15. With regard to the similarity of the services, in its written submissions,⁵ the opponent submits that the parties' services in classes 41 and 45 are identical, with the remaining respective services being similar.

⁵ Written submissions in lieu, dated 17 July 2025 [paragraph 27].

16. In its written submissions,⁶ the applicant submits:

“The Applicant concedes that the services in classes 41 and 45 covered by the Applications are identical with some of the services covered by the Registrations. The Applicant asserts that the services in class 35 of the Applications are different to the services covered by the Registrations.”

My Approach

17. Some of the parties’ services are plainly identical (as conceded by the applicant), for example, ticket reservation services for entertainment events in class 41, and concierge services in class 45. For reasons that will become clear, I will proceed on the basis that all the applicant’s services are identical to services within the opponent’s specifications. If the opponent is unable to succeed on this basis, it will be in no better position if its services are only to be regarded as similar to those of the applicant.

The average consumer and the nature of the purchasing act

18. It is necessary for me to determine who the average consumer is for the respective parties’ services. I must then decide the manner in which these services are likely to be selected by the average consumer in the course of trade. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

19. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

⁶ Written submissions in lieu, dated 17 July 2025 [paragraph 33].

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

20. The average consumer for the services is likely to include members of the general public as well as business users. Given the range of services at issue, the price and frequency of purchase will vary depending on their nature and type. The average consumer is likely to take into consideration various factors when selecting the services at issue, but I would not expect the degree of attention to be at the highest end of the scale. Consequently, I consider that a medium degree of attention is likely to be paid during the purchasing process. However, I acknowledge that business users may pay a slightly higher degree of attention.

21. The services will likely be sought out primarily by eye, including via websites, for example, and so I would expect the purchase to be mainly visual. However, I bear in mind that the services may sometimes be the subject of word-of-mouth recommendations and therefore aural considerations are also borne in mind.

Comparison of the marks



22. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated in *Bimbo SA v OHIM*, that:

“34. [...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of

their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

23. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

24. The trade marks to be compared are as follows:

Opponent’s trade marks	Applicant’s trade marks
<div style="text-align: center;">  <p>THE VENUES COLLECTION</p> <p>(The First Earlier Mark)</p>  <p>THE VENUES COLLECTION</p> <p>(The Second Earlier Mark)</p> </div>	<div style="text-align: center;"> <p>AMERICAN EXPRESS VENUE COLLECTION</p> <p>(the First Application)</p> <p>AMEX VENUE COLLECTION</p> <p>(the Second Application)</p> </div>

Overall Impression

The Opponent’s Marks

25. The First Earlier Mark contains the words ‘THE VENUES COLLECTION’. Whilst these are ordinary dictionary words with independent meanings, I am of the view that they will be perceived as a unit, indicating a collection of venues where, for example, events occur, such as conferences, concerts or sports competitions, etc. Therefore, I find that the overall impression of the words resides in their combination. Positioned centrally above the words is a three-dimensional cube device. As a whole, I find that

the eye is naturally initially drawn to the elements of the mark that can easily be read,⁷ namely 'THE VENUES COLLECTION' which plays a greater role in the overall impression, with the cube device playing a slightly lesser role.

26. The Second Earlier Mark also contains the words 'THE VENUES COLLECTION'. As with the First Earlier Mark, I am of the view that the words will be perceived as a unit, indicating a collection of venues where, for example, events occur, etc. As such, I find that the overall impression of the words resides in their combination. Positioned centrally above and below the words are two touching black triangle devices. When considered as a whole, the device elements give the illusion of a white diamond shape placed upon a black background. As above, I find that the eye is naturally initially drawn to the elements of the mark that can easily be read, namely 'THE VENUES COLLECTION' which plays a greater role in the overall impression, with the device element playing a slightly lesser role.

The Applicant's Marks

27. The First and Second Applications consist of the words 'AMERICAN EXPRESS VENUE COLLECTION' and 'AMEX VENUE COLLECTION' respectively. For reasons that I will come to discuss in the conceptual comparison, I find that the words 'AMERICAN EXPRESS' in the First Application and the word 'AMEX' in the Second Application play independent distinctive roles within the marks, and as such play a greater role in the overall impression. The words 'VENUE COLLECTION', whilst not negligible, play a lesser role in the overall impression.

Visual Comparison

The First and Second Earlier Marks and the First and Second Applications

28. Visually, the competing marks share the same letters 'VENUE_ COLLECTION' / 'VENUE COLLECTION'. However, the First and Second Earlier Marks contain additional elements not replicated in the applications, namely a letter 'S' (after the word

⁷ *MigrosGenossenschafts-Bund v EUIPO*, T-68/17

'VENUE'), the word 'THE' at the start of the mark, and a device element; and the applications contain additional elements not replicated in the earlier marks, namely the words 'AMERICAN EXPRESS' in the First Application and the word 'AMEX' in the Second Application, which appear at the start of the marks. As for the use of colour in the First Earlier Mark, I do not consider this to be a significant difference.

29. Whilst all of the marks at issue contain 'VENUE_ COLLECTION' / 'VENUE COLLECTION', I bear in mind that it is settled caselaw that the beginning of marks tend to have more visual impact than their endings being where consumers tend to focus.⁸ Therefore, weighing up the similarities with the differences, I find the First and Second Earlier Marks and the First and Second Applications to be visually similar to a medium degree.

Aural comparison

The First and Second Earlier Marks and the First and Second Applications

30. Other than the word 'AMEX', the words contained in the marks are all known dictionary words and will likely be pronounced in the ordinary way. The word 'AMEX' will likely be pronounced as either 'A-MEX' or 'AH-MEX'. Accordingly, the words 'VENUES COLLECTION' and 'VENUE COLLECTION' will be pronounced almost identically. The pronunciation of the word 'THE' in the earlier marks and the words 'AMERICAN EXPRESS' in the First Application and the word 'AMEX' in the Second Application will act as points of aural differences. The device elements in the earlier marks will not be articulated. Accordingly, weighing up the similarities with the differences, I find the First and Second Earlier Marks and the First and Second Applications to be aurally similar to a medium degree.

Conceptual Comparison

The First and Second Earlier Marks and the First and Second Applications

⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

31. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court (“GC”) and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

32. As explained above, the ordinary dictionary words ‘THE VENUES COLLECTION’ in the earlier marks and the words ‘VENUE COLLECTION’ in the applications will likely be perceived as a whole, indicating a collection of venues where, for example, events occur, such as conferences, concerts or sports competitions, etc. Accordingly, in view of the services at issue, these elements in the marks are likely to convey the same allusive concept despite the presence of the additional word ‘THE’ in the earlier marks, and the fact that ‘VENUE’ in the applications is in its singular form, whereas ‘VENUES’ in the earlier marks is in its plural form. I say this on the basis that these minor differences do not detract from that concept, nor do they add different concepts. With regard to the device elements present in the earlier marks, these will merely be understood as representing particular designs, etc., but will have no clear relationship with the words ‘THE VENUES COLLECTION’.

33. With regards to the words ‘AMERICAN EXPRESS’ present in the First Application and the word ‘AMEX’ present in the Second Application, it is noted from the opponent’s submissions⁹ that they are of the opinion that the average consumer will merely perceive these elements as ‘house marks’, that is, trade marks used by the applicant to market its range of services, etc. In my view, this implies that the opponent is of the view that the applicant has a reputation for the words ‘AMERICAN EXPRESS’ and ‘AMEX’ and is trying to equate reputation in a trade mark sense with conceptual meaning. They are not the same thing. Reputation can mean different things, but in this context, it concerns the factual extent to which a sign is recognised by a significant part of the public as a trade mark. In contrast, conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trademark acknowledgement) or a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context.¹⁰ Further, I have no

⁹ Submissions in Lieu, dated 17 July 2025 [paragraph 21].

¹⁰ See *AMERICAN EAGLE* (O/593/20).

evidence before me to suggest that for the average consumer 'AMERICAN EXPRESS' or 'AMEX' has acquired an overriding meaning in the sense required for a conceptual comparison. Accordingly, I do not intend considering any potential reputation in the words at issue as a factor in assessing similarity between the respective marks.

34. Therefore, in the absence of any evidence before me to suggest otherwise, conceptually, when considered individually, I am of the view that the words 'AMERICAN' and 'EXPRESS' contained in the First Application, will likely be recognised as having their ordinary dictionary meanings, with which the average consumer will be familiar. However, if considered together the words 'AMERICAN EXPRESS' may evoke the idea of, inter alia, a fast or direct service originating from, or relating to the United States. With regards to the word 'AMEX' in the Second Application, this will likely be perceived as an invented word. Accordingly, however 'AMERICAN EXPRESS' and 'AMEX' are perceived, their inclusion in the applications act as points of conceptual differences between the earlier marks and the applications.

35. Accordingly, whilst I acknowledge that 'VENUES COLLECTION' / 'VENUE COLLECTION' are present in all the respective marks, I find that due to the allusive nature of these elements, this does not equate to a strong point of conceptual similarity. Consequently, I consider the earlier marks and the applications to be conceptually similar to between a low to medium degree.

Distinctive character of the earlier marks

36. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in

Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Alternberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

37. Registered trade marks possess varying degree of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not pleaded that the distinctiveness of its marks have been enhanced through use, nor has it filed any evidence to support such a finding. Consequently, I have only the inherent position to consider.

38. The opponent’s earlier marks contain the words ‘THE VENUES COLLECTION’. Taken as a whole, whilst not directly descriptive, I find that in the context of the services at issue, they allude to characteristics of the services, namely that they are concerned with a collection of venues where, for example, events can be held, such as conferences, concerts and/or sporting competitions, etc. With regards to the figurative elements present in the marks, I appreciate that they will not be overlooked or ignored. However, they are not particularly striking and will not add to the distinctiveness of the marks to any material degree beyond that created by the words. Moreover, they have no obvious meaning in respect of the services at issue. I am reminded that invented words usually have the highest degree of distinctive character, whereas words which are descriptive or allusive of the services relied upon normally have the lowest.

Accordingly, I find the opponent's First and Second Earlier Marks to be inherently distinctive to between a low to medium degree.

Likelihood of confusion

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the respective services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the services may be offset by a greater degree of similarity between the marks and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

40. Earlier in this decision, I found that:

- The services are identical.
- The average consumer for the services will be members of the general public and business users, who will pay at least a medium (but not the highest) degree of attention during the purchasing process.
- The purchasing process will be predominantly visual, although I do not discount an aural component.
- The marks at issue are visually and aurally similar to a medium degree, and conceptually similar to between a low to medium degree.

- The First and Second Earlier Marks are inherently distinctive to between a low to medium degree. On this point, it is acknowledged that a weaker degree of distinctive character in an earlier mark does not preclude a finding of confusion.¹¹

41. Taking all of the above factors into account, I do not consider it likely that the marks will be mistakenly recalled or misremembered as each other. Further, as the purchasing process will be predominantly visual, I consider that the visual differences between the marks will counteract any aural similarity. In my view, the marks are sufficiently visually different to avoid direct confusion, even when the marks are used on identical services. Accordingly, I do not consider there to be a likelihood of direct confusion.

42. I will now consider whether there is a likelihood of indirect confusion. *In L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., (as he then was) as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

43. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

¹¹ See *L'Oréal SA v OHIM*, Case C-235/05 P

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand 16 extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

44. I bear in mind that this list is not exhaustive. I also bear in mind that there must be a "proper basis" for finding indirect confusion where there is no direct confusion.¹²

45. In relation to assessing the likelihood of confusion where the common element is lowly distinctive, I keep in mind that in *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, Emma Himsworth KC, as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHC 3303 (Ch), as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Miss Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

"(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

¹² *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements. The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

46. I have previously found that the common word elements, ‘THE VENUES COLLECTION’ / ‘VENUE COLLECTION’, are distinctive to a lower degree due to their allusive nature in terms of the services at issue. As a result, greater weight will be attributed to the remaining elements of the contested applications, namely the words ‘AMERICAN EXPRESS’ in the First Application and the word ‘AMEX’ in the Second Application, neither of which have any obvious meaning in respect of the services, and therefore are sufficiently more distinctive than the common elements ‘THE VENUES COLLECTION’ / ‘VENUE COLLECTION’. I also keep in mind the figurative elements present in the earlier marks, which play a role in their overall impression.

47. Accordingly, whilst the marks may share a conceptual similarity derived from the shared ‘THE VENUES COLLECTION’ / ‘VENUE COLLECTION’, I am of the view that this shared concept is not materially significant, especially as the concept relates to the services being provided. Therefore, I find that the visual and aural differences between the First and Second Earlier Marks and the First and Second Applications are sufficient to differentiate between them. Notwithstanding the degree of attention being at least a medium degree (but not the highest), I consider that the additional

elements in the applications will be sufficient to enable the consumer to differentiate between them. I say this even in the case of identical services. The words 'THE VENUES COLLECTION' / 'VENUE COLLECTION', would simply be seen by consumers as reference to the services at issue, therefore, these words are not so distinctive that consumers would assume that only one undertaking would use them in their mark. In my opinion, the average consumer would merely put the presence of the common elements in the marks down to coincidence rather than economic connection. Therefore, taking all the above into account, I find that there is no likelihood of indirect confusion between the opponents First and Second Earlier Marks and the First and Second Applications.

CONCLUSION

48. The oppositions based upon section 5(2)(b) of the Act have failed. Therefore, the applications may proceed to registration.

COSTS

49. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £850, calculated as follows:

Preparing counterstatements and considering the notices of opposition (x2):	£500
Preparing submissions in lieu:	£350
Total	£850

50. I therefore order Compass Group, UK and Ireland Limited to pay American Express Marketing & Development Corp., the sum of £850. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of January 2026

**Sam Congreve
For the Registrar**

Annex 1

Class 35

Providing access to a collection of sports and entertainment arenas, stadiums, grounds, stages, theatres, through loyalty, incentive and bonus schemes; advertising and promotional activities for loyalty, incentive and bonus program services; distribution of advertising, marketing and promotional material; promoting the sale of goods and services of others by awarding purchase points for credit card use; promoting the sale of credit card accounts through the administration of incentive award programs.

Class 41

Ticket reservation and booking services for education, entertainment and sports activities and events; arranging for ticket reservations for shows and other entertainment events; arranging for ticket reservations and admission to music, theater, fashion, film, and sports events.

Class 45

Concierge services; concierge services for others comprising making requested personal arrangement and reservations and providing customer-specific information to meet individual needs rendered to credit card customers.

Annex 2

Class 39

Transport; travel arrangement; services for the booking of transport; conducting, arranging and organising tours and trips; information, advisory and consultancy services in relation to all of the aforesaid services.

Class 41

Ticketing, reservation and information services relating to entertainment, concerts, sporting, cultural, educational and theatrical events; organisation and management of entertainment, concerts, sporting, cultural, educational and theatrical events; hospitality services (entertainment); education; providing of training; entertainment; sporting and cultural activities; information relating to entertainment or education provided on-line; arranging and conducting of seminars, conferences and exhibitions; exhibition services; organisation of team building events; organising weddings and events; organisation of corporate hospitality events; event co-ordination services; ticketing, reservation and information services relating to entertainment, concerts, sporting, cultural, educational and theatrical events; organization and management of entertainment, concerts, sporting, cultural, educational and theatrical events; hospitality services (entertainment); provision of exhibition, art gallery and museum facilities; art gallery and museum services; information, advisory and consultancy services in relation to all of the aforesaid services.

Class 43

Services for providing food and drink; temporary accommodation; catering services; contract food services; hospitality services [food and drink]; arranging of wedding receptions; corporate hospitality services [food and drink]; banqueting services; restaurant services; bar services; cafés, cafeterias, canteens, restaurants, snack-bars, coffee shops, bars, pubs, cocktail bars, tea rooms, bistros, brasseries, delicatessens; mobile catering services, takeaway services; food cooking services, preparation of food and drink; hotel and restaurant information services; consultancy services relating to food and drink; providing food and drink through vending machines; providing food and beverages from a concession stand; reservation of accommodation; venue hire; rental of meeting rooms and seminar rooms; rental and hire of temporary

accommodation; rental and hire of furniture; information, advisory and consultancy services relating to the aforesaid services.

Class 45

Arranging and planning wedding ceremony services; concierge services; information, advisory and consultancy services relating to the aforesaid services.